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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/658,562

Filing Date: September 08, 2003

Appellant(s): GAUSELMANN, MICHAEL

Brian D. Ogonowsky
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7 October 2008 appealing from the Office action mailed 11 July 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The editorial comment regarding Bueschel is out of place in the statement of grounds for rejection.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

6,224,482	Bennett	05-2001
5,655,961	Acres et al.	08-1997

Bueschel, Richard M., *Lemons, Cherries, and Bell Fruit Gum*, Royal Bell Books, 1995, page 85

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 18, 19, 22, 24 & 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US Patent Number 6,224,482) in view of Bueschel (*Lemons, Cherries & Bell Fruit Gum*, Royal Bell Books, 1995 page 85) & Acres et al. (US Patent Number 5,655,961).

Claims 18, 19, 24: As noted in the previous office action, Bennett teaches the invention substantially as claimed, but fails to teach dynamically adjusting the percentage of wagers from the paid games to the free game pot depending on a level of the free game pot. Jackpots were adopted early in the history of the slot machine. In the 1920's, jackpots became popular. On page 85 of Bueschel's book, there is a copy of an advertisement from that period. It explains how jackpots were funded. A player put a coin in the slot & if the jackpot was not full, the coin went into the jackpot. If the jackpot was full, the coin either went into another jackpot (even in the 1920's, slot machine designers knew the importance of making sure there was a full jackpot available to players before playing a jackpot game) or into the cash box. This was achieved through "well balanced shut-off gates". (See paragraph 2.) Thus until the jackpot was full, one

percentage (100%) of all wagers went into the jackpot. Once the jackpot was full, the well-balanced shut-off gates were closed & another percentage (0%) of all wagers went into the jackpot. This ensured that the jackpot filled quickly, thus attracting players) while making sure that the operator made money. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bennett in view of Bueschel to dynamically change the percentage of the wagers devoted to the jackpot in order to ensure that the jackpot filled quickly, thus attracting players) while making sure that the operator makes money.

In the 1920's game designers did not have the technology to take a percentage of wagers less than 100% and assign it to the progressive jackpot. After all, a jackpot was a physical "pot" into which coins were placed. If a player placed a nickel in the slot, either the nickel went into the jackpot or it did not. It was impossible to split the nickel into pieces & place some of the pieces in the jackpot & some in the casino till.

Technology has advanced. A slot machine's jackpot is no longer a physical construct. It is a logical construct (i.e., an account) held in a computer's memory. A player's nickel can be divided any way that the casino desires since it is now represented electronically. Today, most progressive jackpots are funded by taking a portion of the player's wager that is less than 100% and assigning it to the progressive jackpot account in the casino's (or slot machine's) computers.

Clearly, it is within the level of ordinary skill to set the percentages going into the jackpot at any level desired —including less than 100%. Furthermore, since at least the 1920's practitioners of the art have been changing the percentages of wagers going into

the jackpot based on jackpot level. (Any other criteria might be chosen if desired.)

Certainly, using percentages other than 100% would yield predictable results. Examiner concludes that it would have been obvious to assign a percentage less than 100% to the free game pot.

Regarding only fully funding of the free game bonus round, it should be noted that Bennett already has this feature. Since Bennett teaches dividing the existing jackpot into portions, Bennett always has a jackpot that is capable of funding all play of the bonus game. Examiner however, interprets the claims as requiring the free games to be played only when the jackpot reaches a certain level.

Bueschel's double jackpot system's purpose was to ensure that the jackpot was full before a jackpot was awarded. In the 1920's, it was not possible to issue signals based on the level of the jackpot. In those days, designers had to rely on probability to keep the player from winning prior to the jackpot filling. However, with the computer age, it became possible to monitor the jackpot level & only allow a jackpot when the pool is full. This is what Acres teaches (see claim 8).

The importance of a full jackpot cannot be overestimated. If Bennett's jackpot does not reach a certain level, then it will not attract players. Players like to play for large amounts.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bennett in view of Bueschel & Acres to initiate the bonus round after the jackpot is at a level necessary to ensure full funding of all free games

played during the free game round (i.e., reaches a certain level) in order to ensure that the jackpot is large enough to attract players.

Claim 22: Bueschel teaches a plurality of pots. The names of the pots (i.e., jackpot or free game pot) are immaterial and do not patentably distinguish over the prior art.

Claim 59: The choice of funding levels is a matter of design choice. A casino may choose any level of funding deemed appropriate. Acres teaches that the casino decides the appropriate funding level. Acres also teaches adjusting the frequency of bonus games based on current play conditions. (Paragraphs 294-296) Thus Acres suggests determining the funding level based on current conditions. This for instance, allows the casino to attract more players during slow times by offering more frequent bonuses. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bennett in view of Bueschel & Acres to set the level of the pot necessary to ensure full funding based on playing conditions.

(10) Response to Argument

Examiner's Summary

1. After reading Appellant's Appeal Brief, it appears that Appellant & Examiner are arguing at cross purposes. It is apparent to Examiner that Appellant is not claiming the invention argued. It is equally apparent that Examiner's rejection is not clearly explaining why he makes this contention.
2. The crux of the matter appears to be the free game pot. There are a number of pots associated with the free game bonus round. For instance, in paragraph 0041 of the published application, we find jackpot 1, jackpot 2, hidden JP1, hidden JP2 & free game pot. Taken alone,

any of these could be considered to be the claimed “free game pot”. In fairness to the Appellant, taken alone, the last pot in the list would have the best claim to that designation – the specification calls it a “free game pot”.

3. Unfortunately for the Appellant, we cannot take these words alone. We must read the claim as a whole and the specification as a whole and apply the broadest reasonable interpretation of the claimed limitations. Appellant claims that the free game pot is used to fund the free game bonus round. In all cases, the free game bonus round is funded by jackpot 1 or jackpot 2 – the jackpots serve as a prize in all embodiments of the disclosed free game bonus round. But the so-called “free game pot” is not used to fund the free game bonus round in the embodiment in which the players play for points. (Since players play for points with the jackpot as the only prize, the casino has no additional risk during the free games. Therefore, there would be no requirement for “virtual wagers”.)

4. Examiners may not read limitations from the specification into the claims. Furthermore, unless there is a definition section that explicitly requires that a term be given a specific definition, examiners must use the broadest reasonable interpretation in light of the specification. In this case, there is no explicit definition applies to the term “free game pot”. (I.e., The specification does not contain a statement to the effect that, “By free game pot, this disclosure means...”) Examiner contends that it is reasonable to interpret the term as meaning any pot that is used to fund the free game bonus round. Furthermore, since the so-called jackpots always fund the free game bonus round & the so-called free game pot only funds the free game bonus round in one embodiment, it is perhaps more reasonable to interpret the term in favor of the former instead of the later.

5. Examiner readily admits that had Appellant claimed a free game pot that was used to fund virtual wagers during the free game bonus round, the cited prior art would not teach this feature. But Examiner contends that this is not claimed & Appellant's arguments on this score are not commensurate in scope with the claims.

6. Since the Appellant's arguments depend almost entirely on the definition of a free game pot, this is the major issue before the Board – Is the Examiner's interpretation the broadest reasonable interpretation in view of the specification? Or must the Examiner read the limitation concerning funding virtual wagers into the claims?

Response to Appellant's Arguments

7. Appellant argues that the prior art fails to teach a “free game pot” that funds the wagers for a free game bonus. As noted above, Examiner admits this is true, but contends that funding wagers is not claimed --merely funding the free game bonus round. Since the jackpots are always used to fund the free game bonus round (i.e., provide the prizes), these jackpots read on the claimed invention.

8. Appellant argues that Bueschel does not teach a progressive jackpot because there is a limit to the funding of the jackpot. This is immaterial. Bueschel clearly teaches a jackpot that is funded by taking a portion of the player's wager. This is all that is claimed. Applicant has not claimed any unbound “free game pot”.

9. Appellant argues that the reason Bueschel stops funding the jackpot is unrelated to the reason Appellant stops funding the “free game pot”. Again, these reasons are beyond the scope of the claims. Examiner disagrees. Appellant states that the “purpose of Applicant's invention is to avoid the financially [sic] inefficiency in excess funding of the free game pot since that excess

money could have been applied elsewhere..." (Brief, page 7) Bueschel's device avoids the financial inefficiency in excess funding of the jackpot in order that the excess money could be applied elsewhere -- to the casino's profits. Furthermore, the fact that appellant has recognized another advantage (to the extent that it is another advantage) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

10. Applicant argues (in two different places) that the concept of quickly filling a jackpot and then adding no more to the jackpot is inapplicable to modern linked gaming machines since a fixed jackpot is paid out from the slot machine's coin hopper. Of course, this is not the proper test for obviousness. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Examiner contends that Bueschel would suggest to one of ordinary skill that a pot may be filled with player contributions & when the pot is filled, no more contributions are made to the pot.

11. Appellant argues that the "free game pot" is not a progressive pot because it has a limit. First Appellant argued that Bueschel's pot is not applicable to the present invention because it has a limit. Now Appellant argues that Bueschel's disclosure should not be applied to the Appellant's invention because Appellant's "free game pot" has a limit. Clearly both arguments cannot apply.

12. It should be noted that while Appellant does not discuss the fact at any length, Acres teaches a modern linked system of gaming machines with a limited pot funded by player contributions. Acres discloses that when a trigger event occurs, the bonus round is played until the pot is depleted. One of the trigger events may be the pot reaching a certain funding level. Thus the pot's size has an upper limit, just like Bueschel's.

13. With regard to claim 22, Appellant argues that Bueschel's plurality of pots is not the claimed plurality of pots. This argument is based on Appellant's (unclaimed) definition of a "free game pot".

14. With regard to claim 24, Appellant argues that once the free game pot is full, more of the wager goes to the jackpot. Bueschel teaches that when one pot is full, the coins are diverted to fill the second pot. This is precisely analogous to Appellant's claimed invention.

15. With regard to Claim 59, Appellant argues that "Acres does not disclose or suggest that the "turn-on level" of the bonus pool "is not predetermined but is dependent upon current conditions while paid games are being played"..." (Brief Page 10) This is not commensurate in scope with the claims. Claim 59 says absolutely nothing about "turn-on" levels of the bonus pool. Claim 59 talks about turning off funding for the pot.

16. Perhaps Appellant meant to argue that Acres does not teach that the turn-on level of the bonus game is dependent on current conditions. Since Acres' teaches depleting the bonus pool when the bonus game is turned on, this would be essentially what Appellant is claiming in claim 59. The problem with that argument is that Acres clearly does teach that turning on the bonus game (and thus turning off jackpot funding) is dependent on current conditions of play. In paragraph 296, Acres teaches that one of the bonus conditions may include "a minimum level of

play in the time period prior to the bonus pool reaching the turn on level...” Since Acres teaches accumulating money in the pot until the bonus round is started, this means that the level of funding of the pot is not predetermined but is dependent on current conditions while paid games are being played. Appellant’s “hindsight” argument has no merit – there is no hindsight involved in making logical conclusions from the reference’s plain disclosure.

17. Appellant closes the Brief with an indication that certain amendments would be acceptable to the Appellant. One of these proposed amendments would bring Appellant's claims into agreement with Appellant's arguments (i.e., amending the claims to clarify that the free game pot is used to fund virtual wagers). Examiner believes that this (highly unusual) section of Appellant's Brief highlights his contention that this case is primarily a question of claim interpretation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner

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